



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bernd MISSELWITZ

Examiner: JONES, Dameron Levest

Serial No.: 10/616,511

Group Art Unit: 1618

Filed: July 10, 2003

Title: USE OF PERFLUOROALKYL-CONTAINING METAL COMPLEXES AS
CONTRAST MEDIA IN MR-IMAGING FOR VISUALIZATION OF
INTRAVASCULAR THROMBI

Pre-Appeal Brief Request for Review

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Office Action mailed on May 19, 2006, in conjunction with the concurrently filed Notice of Appeal, applicants request the pre-appeal brief review of two outstanding double patenting rejections in this application.

The First Obviousness-type Double Patenting Rejection

Claims 1 and 30 are rejected as allegedly unpatentable under obviousness type double patenting over claim 51 of co-pending US 10/857,877.

The claims of the present application are directed to the MR imaging of “intravascular thrombi.”

The claims of US ‘877 are directed a method of “conducting MRI imaging, and visualizing plaque, infarcted tissue, or necrotic tissue in which contrast agent is uptaken, or independently simultaneously visualizing necroses and tumors in which contrast agent is uptaken.” (Emphasis added.) See the last part of independent claim 51, on page 11 of the preliminary amendment of ‘US ‘877.

The Office Action dated May 19, 2006, (hereinafter the Office Action) alleges that the

claims of the reference application and of the present application teach methods where the contrast agents are “used for the same type of imaging,” and thus, “the applications contain overlapping subject matter.” See end of second paragraph of page 3 of Office Action.

Imaging “intravascular thrombi” does not overlap the imaging of “plaque, infarcted tissue, or necrotic tissue” or of “necroses and tumors.” While very broadly one can say that both visualizations are done with a contrast agent using MRI, such generalization merely defines a universe of imaging methods with many non-overlapping species. Just because two inventions are within the same universe of technology very broadly speaking, it does not follow that every invention within such universe is obvious in view of other inventions therein. However, such is the basis of the rejection here, which is improper.

One of ordinary skill in the art facing a teaching that a contrast agent, for example, accumulates in plaque, infarcted tissue, or necrotic tissue or necroses and tumors, and makes their visualization possible using MRI, would not be motivated to use the same contrast agent for intravascular thrombi to making its MRI visualization possible. Nor would there be a reasonable expectation of success of such visualization.

For example, the mechanism of contrast agent uptake is a variable that is expected to be different among these various tissues, structures, etc., based on the completely different histopathological composition of these various tissues, structures, etc. One of ordinary skill in the art would expect that these variations in tissues, structures, etc., and the various mechanisms of uptake of contrast agent to influence whether such tissues, structures, etc., can be visualized when subjected to a specific contrast agent. The targets of the reference’s claims do not render obvious the target of the present claims.

Moreover, no factual basis has been provided in the rejection that would support that one of ordinary skill in the art would expect that a contrast agent useful for the visualization of the reference's various tissues, structures, etc., would also be useful for the visualization of intravascular thrombi.

At most the allegations may be adequate to support an allegation that it may be obvious to try, which is not admitted, to visualize various tissues and/or structures, e.g., bone tissues, vascular tissues, nerve tissues, liver tissue, etc., using the contrast agent of the reference with MRI and see for which tissues and/or structures the imaging provides useful MR images.

However, obvious to try is not the test for obviousness-type double patenting. See *Abbott Laboratories v. Andrx Pharmaceuticals Inc.*, 79 USPQ2d 1321 (CA FC 2006). Something in the prior art must teach or suggest the modification to one of ordinary skill in the art to achieve the claimed invention for such to be obvious, or for such to be unpatentable under obviousness-type double patenting. That is lacking in the rejection made against the present claims.

For all the foregoing reasons, the claims of the present application are not obvious from the claims of US '877.

The Second Obviousness-type Double Patenting Rejection

Claims 1-29 and 45-49 are rejected as allegedly unpatentable under obviousness type double patenting over claims 1-35 of US 6,818,203.

The allegation in this rejection too, as in the one discussed above, relies on the inventions of the present claims and of the reference being in the same technological universe, broadly speaking. The Office Action merely states that “although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a method of MRI imaging wherein tissue may be visualized.” See page 4, last paragraph on the page, of the Office Action.

Claim 1 of US '203, and all the rest of the claims too which are dependent on claim 1, are directed to a method of MRI imaging where “plaque in which contrast agent is uptaken,” or “necroses and tumors in which contrast agent is uptaken” are visualized.

Thus, the arguments from above, as they apply to this second rejection too, are incorporated herein also.

As an additional allegation the Office Action alleges that “a skilled practitioner in the art would recognize the contrast agent may be used to detect both plaques and thrombi as set forth in the specification of the instant invention.” See paragraph spanning pages 4 and 5 of the Office Action.

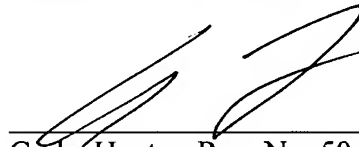
Primarily, it has long been established that reliance on applicants' own teaching in the specification of the application at issue is improper in an obviousness-type double patenting rejection. See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 USPQ2d 1839 (CA FC 1992) and *In re Sarett*, 140 USPQ 474 (CCPA 1964).

Additionally, the material pointed out in the specification states that "The MR images clearly show, however, that plaques and thrombi can be distinguished clearly from one another. This is therefore important, since thrombi in the young stage can be mobile and can result in lethal embolisms." This merely discusses the results of the imaging done for purposes of this application and does not admit anything with respect to what one of ordinary skill in the art would have found obvious in view of the prior art.

Reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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